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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/601,029	07/26/2000	PETER HIMMELSBACH	BEIERSDORF-6	5165

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EXAMINER

PIERCE, JEREMY R

ART UNIT

PAPER NUMBER

1771

DATE MAILED: 03/18/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/601,029

Applicant(s)

HIMMELSBACH ET AL.

Examiner

Jeremy R. Pierce

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 January 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

1. Amendment C has been filed on January 24, 2003 as Paper No. 11. Claims 1 and 2 have been amended. Claims 29-32 have been added. The amendment is sufficient to overcome the 35 USC 102 and 103 rejections set forth in sections 3-9 of the last Office Action.

### ***Claim Rejections - 35 USC § 103***

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Claims 1-5, 7-10, 15-17, and 21-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kantner et al. (U.S. Patent No. 5,489,624) in view of Riedel (U.S. Patent No. 4,967,740).

Kantner et al. disclose an adhesive useful in delivering pharmaceuticals or other active ingredients to or through mammalian skin (Abstract). Kantner et al. disclose the backing layer of the medical tape should have a high moisture vapor transmission (column 11, line 66 –column 12, line 2), but do not disclose using a nonwoven overstitched by yarns. Riedel discloses a moisture vapor permeable tape for use on mammalian skin (column 1, lines 8-12). The backing material can be nonwoven and particularly a stitch-bonded fabric (column 3, lines 40-59). Riedel discloses that the preferred backing exhibits a desired combination of inherent properties such as

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moisture vapor permeability, softness, yield modulus, and strength. It would have been obvious to one having ordinary skill in the art to use the backing of Riedel in the medical tape of Kantner et al. in order to obtain a backing material with the desired combinations of moisture vapor permeability, softness, conformability, yield modulus, and strength, as taught by Riedel. With regard to claims 3, 21, and 22, Riedel does not disclose how many stitches are present on backing layer of a stitch-bonded fabric per centimeter.

The number of stitches in the backing layer would be a result effective variable that would alter the strength of the web. It would have been obvious to one having ordinary skill in the art to provide 5 to 50 longitudinal stitches per centimeter in order to create a stitch-bonded fabric with a desired strength and rigidity provided by the stitches, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

With regard to claim 4, although Riedel does not explicitly teach the limitation of the compression force generated by the backing material at an elongation of 20 to 70%, it is reasonable to presume that said limitations are inherent to the invention. Support for said presumption is found in the use of similar materials (i.e. polyester) and in the similar production steps (i.e. stitch-bonded nonwoven) used to produce the medical tape. The burden is upon the Applicant to prove otherwise. *In re Fitzgerald*, 205 USPQ 594. In the alternative, it would have been obvious to one having ordinary skill in the art to provide a compression force of from 0.2 N/cm to 10 N/cm at an elongation of from 20 to 70% in order to create a medical tape with the desired strength, elongation, and break properties that are known in the art to be adjustable. With regard to claims 5 and

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23, Riedel do not disclose a basis weight for the backing material. If not already inherent due to the broad claimed range and the use of Riedel as a medical tape, it would have been obvious to a person having ordinary skill in the art to provide a stitch-bonded nonwoven with a basis weight of between 10 and 350 grams per square meter, since such a range would include many tapes already known in the medical art, and it would be desirable to select a basis weight of the backing layer that is commonly used in the art of medical tapes. With regard to claim 7, the fact that Kantner et al. and Riedel disclose medical tape would mean that the material is capable of tearing. With regard to claims 8 and 24, the releasable active substance can be incorporated in an amount of 0.01 to 10% by weight of adhesive (column 9, lines 42-43). With regard to claim 9, the adhesive in Kantner et al. is melted above 50 degrees Celsius (column 13, line 44). With regard to claims 10, 25, and 26, although Kantner et al. do not explicitly teach the limitations of dynamic-complex glass transition temperatures, it is reasonable to presume that said limitations are inherent to the invention because the invention of Kantner is also used as a medical tape to be applied to mammalian skin. In the alternative, it would have been obvious to one having ordinary skill in the art to use adhesive with the claimed glass transition temperatures in order to provide the optimal amount of tackiness for use as a medical tape. With regard to claims 15, 27, and 28, neither Kantner et al. nor Riedel disclose the weight per unit area of the adhesive on the backing material. Having between 130 and 500 grams per square meter of adhesive would likely be inherent to the material of Kantner et al. and Riedel because both references are also used as medical tapes. If not, it would have been obvious to one

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having ordinary skill in the art to provide between 130 and 500 grams per square meter of adhesive in order to create a medical tape with the desired amount of adhesion property fit for its intended use. With regard to claim 16, although not specifically mentioned, the adhesive disclosed by Kantner et al. is capable of being sterilized by gamma radiation. With regard to claim 17, Riedel discloses treating the backing material with a release coating for low adhesion (column 4, lines 3-14). With regard to claims 29-32, Kantner et al. disclose several examples of biologically active material that would exist in particle form (column 9, lines 28-41).

4. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kantner et al. in view of Riedel and further in view of Bodenschatz et al. (U.S. Patent No. 6,074,965).

Riedel does not teach reinforcing fibers in the nonwoven backing layer. However, Bodenschatz et al. already teach a medical material that is supported with high-strength fibers with a maximum tensile strength over 60 cN/tex (Abstract). It would have been obvious to one having ordinary skill in the art to reinforce the stitch-bonded nonwoven web of Riedel with high-strength fibers in order to create a tape with increased strength, as taught by Bodenschatz et al.

5. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kantner et al. in view of Riedel and further in view of Bredahl et al. (U.S. Patent No. 5,539,033).

Kantner et al. and Riedel fail to disclose foaming the adhesive layer prior to application to the backing layer. Bredahl et al. teach a process for making pressure sensitive adhesive tape, including medical tapes (column 9, lines 43-50). Bredahl et al.

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disclose the adhesive layer can be foamed (column 8, lines 58-65). It would have been obvious to one skilled in the art to foam the adhesive in the tape of Kantner et al. in view of Riedel prior to applying to the backing layer in order to increase the air permeability of the adhesive.

6. Claims 12, 13, 18, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kantner et al. in view of Riedel and further in view of Ganschow (U.S. Patent No. 5,629,078).

With regard to claims 12 and 13, Kantner et al. and Riedel do not disclose the manner in which the adhesive is applied to the backing material. Ganschow discloses a back-coated adhesive tape based on a stitch-bonded web (column 1, lines 1-8).

Ganschow teaches the application of the adhesive by various processes, including screen printing and spraying (column 2, lines 4-11). It would have been obvious to one having ordinary skill in the art to apply the adhesive to the backing material of Riedel in a manner disclosed by Ganschow, in order to provide the adhesive on the backing in a manner typical in the art of adhesive tape. With regard to claims 18 and 20, Riedel does not disclose the further providing of an additional layer to the backing material.

Ganschow teaches providing such layers in order to make the tape easily releasable when wound into a roll. Ganschow adds a water repellent foam layer (column 1, lines 35-45) and an acrylate lacquer on top of the foam (column 1, lines 61-65). It would have been obvious to one having ordinary skill in the art to provide the tape of Kantner et al. in view of Riedel with the foam and acrylate lacquer in order to make the tape waterproof and easily releasable, as taught by Ganschow.

7. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kantner et al. in view of Riedel and further view of Crawley et al. (U.S. Patent No. 5,948,707).

Kantner et al. disclose applying the mixture in a pattern coating (column 8, lines 10-14). However, neither Kantner et al. nor Riedel disclose adding the adhesive in polygeometric domes. Crawley et al. disclose a non-slip waterproof fabric (Abstract). Crawley adds a layer of elastomeric material in the forms of dome-like projections to the fabric that gives the fabric a gripping capability when contacted with skin (column 7, lines 5-45). It would have been obvious to one skilled in the art to put the adhesive layer in the form polygeometric domes in the tape taught by the combination of Kantner et al. and Riedel in order to make a tape that did not adhere too strongly to the human skin, and peeled off with less resistance.

8. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kantner et al. in view of Riedel and further in view of Seabold et al. (U.S. Patent No. 4,315,047).

Kantner et al. disclose using metallized polymeric film (column 8, lines 15-16). However, neither Kantner et al. nor Riedel teach coating the backside of the tape with metal vapor. Seabold et al. teach that adhesive tapes may be coated with metal vapor on the backside as a means of rendering the tape opaque (column 6, lines 65-68). It would have been obvious to one having ordinary skill in the art to add metal vapor to the backing of Riedel in order to make the tape non-transparent, as taught by Seabold et al.

### ***Response to Arguments***



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9. Applicant's arguments with respect to claims 1-32 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

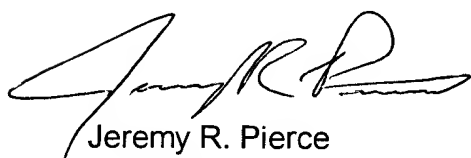
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeremy R. Pierce whose telephone number is (703) 605-4243. The examiner can normally be reached on Monday-Thursday 7-4:30 and alternate Fridays 7-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (703) 308-2414. The fax phone numbers

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for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



Jeremy R. Pierce  
Examiner  
Art Unit 1771

March 12, 2003



ELIZABETH M. COLE  
PRIMARY EXAMINER